

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NOBUYUKI AOSHIMA
and TAKEYASU YAMAMOTO

Appeal No. 1999-2666
Application No. 08/565,584

HEARD: January 11, 2001

Before FLEMING, RUGGIERO, and LEVY, Administrative Patent Judges.

LEVY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-8 and 11-22, which are all of the claims pending in this application.

BACKGROUND

The appellants' invention relates to a video game apparatus which provides advice information to a user. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced as follows:

1. A video game apparatus comprising:
a display;
game operating means operated by a player;
game computing means for computing a game in accordance with an operation signal from said game operating means and a predetermined game program to display a game image on said display; and
advice data computing means which computes and outputs advice data for the player depending on a state of the game, wherein said advice data computing means comprises an operational state judging section for judging an operational state of the game operating means from an operational history of the player, the advice data computing means automatically generating an operation advice image of the game operating means, and displays the operation advice image on the display depending on the operational state.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Okada	4,752,069	Jun. 21, 1988
Eisen et al. (Eisen)	4,964,077	Oct. 16, 1990
Lanier et al. (Lanier)	5,103,498	Apr. 7, 1992
Mott et al. (Mott)	5,269,687	Dec. 14, 1993
Pierce et al. (Pierce)	5,299,810	Apr. 5, 1994

Claims 1-8, 14-16, and 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Lanier in view of Okada. Claims 11-13 and 21 stand rejected under 35 U.S.C. § 103 as being unpatentable over Lanier in view of Okada, and further in view of Mott. Claims 17 and 22 stand rejected under 35 U.S.C. § 103 as being unpatentable over Lanier in view of Okada, and further in view of Eisen. Claims 18 and 19 stand rejected under 35 U.S.C. § 103 as being unpatentable over Lanier in view of Okada, further in view of Mott and Pierce.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 17, mailed March 2, 1999) and the final rejection (Paper No. 11, mailed June 9, 1998) for the examiner's complete reasoning in support of the rejections, and to the appellants' brief (Paper No. 16, filed January 19, 1999) and reply brief (Paper No. 18, filed April 27, 1999) for the appellants' arguments thereagainst. Only those arguments actually made by

the appellants have been considered in this decision. Arguments which the appellants could have made but chose not to make in the briefs have not been considered. See 37 CFR 1.192(a).

OPINION

In reaching our decision in this appeal, we have carefully considered the subject matter on appeal, the rejections advanced by the examiner, and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the invention as set forth in claims 1-8 and

11-22. Accordingly, we reverse, essentially for the reasons set forth by the appellants.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the

examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicants to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole. See id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

We consider first the rejection of claims 1-8, 14-16, and 20 based on the teachings of Lanier in view of Okada. The Appellants assert (brief, pages 10-12) that there is no motivation to combine Lanier with Okada. Lanier is directed to an intelligent help system and is not directed to a video game, as is Okada. The appellants state (reply brief, page 2) that

Lanier is a "click-on" help system. The dynamic nature of a game would not be compatible with such a system. In fact, Lanier's "click-on" help system would be detrimental in a game environment because

it would require the person to stop, "click on" the right button, menu etc., read and understand the appropriate help message, and the resume the game.

In addition, the appellants asserts that Lanier teaches away from providing help information automatically. In Lanier, the user is provided with help only when assistance is requested by the user. The appellants assert (reply brief, page 3) that

if a user does not request help, Lanier system assumes that the user does not need help and stores historical information only after a user has requested help. Therefore, Lanier's system would not operate in its intended fashion if the help information was provided "automatically". Thus, Lanier's help system actually teaches away from providing advice data automatically.

The appellants further assert (reply brief, page 4) that the examiner appears to be engaging in impermissible hindsight to achieve the appellants' claimed invention. The appellants state (id.)that

Okada would not have been motivated to use the click-on, pull down menu system of Lanier or any other help system because Okada had already provided a user with arrows that were adequate to let the player know what to do to achieve success for the disclosed game. (underlining original).

We find that help system of Lanier provides assistance to a user, when requested (col. 2, lines 1-5). The assistance is

provided for items such as how to select and copy text from a file menu (col. 7, lines 9-13). Having determined that the user has mastered the task, monitoring device 320 updates the user's historical information. We find that Okada, in contrast, is directed to a video game. Advice to a player regarding time remaining and operating direction is provided to a user is based upon a clock pulse counter 20 (col. 1, lines 46-51 and col. 4, lines 6 to 14).

The examiner (answer, page 5) relies upon the teaching in Lanier (col. 2, lines 52-55) that Lanier's system could be implemented in other operating environments. We find however, that this teaching of Lanier does not extend to a video game. In Okada, advice is provided in order to enable the user to react more quickly while playing the video game. We find this to be different from Lanier where the training is cognitive in nature.

We therefore find that one of ordinary skill in the art would not have been taught to combine the teachings of Okada to the computer help system of Lanier to add a game as well as a system for providing automatic advice as advanced by the examiner. Obviousness may not be established using hindsight

or in view of the teachings or suggestions of the inventor.
Para- Ordnance Mfg. v. SGS Importers Int'l, 73 F.3d 1085,
1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995)(citing W.L. Gore &
Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1551, 1553, 220
USPQ 303, 311, 312-13 (Fed. Cir. 1983)). "It is impermissible
to use the claimed invention as an instruction manual or
'template' to piece together the teachings of the prior art so
that the claimed invention is rendered obvious." In re
Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir.
1992)(citing In re Gorman, 933 F.2d 982, 987, 18 USPQ2d 1885,
1888 (Fed. Cir. 1991)).

Because Lanier does not address the issue of providing
advise in order to obtain quick reflexive response by the user
of a dynamic game, we are not persuaded that teachings from
the applied prior art would appear to have suggested the
claimed limitations. The examiner has therefore failed to
establish a prima facie case of obviousness. Accordingly, the
rejection of claims 1-8, 14-16 and 20 as obvious over Lanier
in view of Okada under 35 U.S.C. § 103 is reversed.

We turn next to the rejection of claims 11-13 and 21 as
unpatentable over Lanier in view of Okada, further in view of

Mott. We begin with claims 11-13, which depend from claim 1. As Mott does not overcome the deficiencies of Lanier and Okada, the rejection of claims 11-13 under 35 U.S.C. § 103 is reversed. Turning to claim 21, we find that Mott does not overcome the deficiencies of Lanier and Okada. In addition we find that while Mott teaches displaying gauges to provide advice to a player, Mott does not teach "judging data of gauges used in the game . . . advising the player on a current state of a gauge and displays the advice image on the display depending on the judging data." Moreover, we find no suggestion to provide Okada with gauges as tachometers, would not be of value in Okada's game. Accordingly, the rejection of claim 21 under 35 U.S.C. § 103 is reversed.

Turning next to the rejection of claims 18 and 19 as unpatentable over Lanier in view of Mott, further in view of Okada and Pierce, as Mott and Pierce do not overcome the deficiencies of Lanier and Okada, the rejection of claims 18 and 19 under 35 U.S.C. § 103 is reversed.

We turn next to the rejection of claims 17 and 22 under 35 U.S.C. § 103 as unpatentable over Lanier in view of Okada, further in view of Eisen. We find that Eisen does not overcome the deficiencies of Lanier and Okada, and would not be combinable with the game of Okada for the reasons discussed above with respect to Lanier. In addition, we find that Eisen teaches (col. 2, lines 28-47) a help system in which the amount of help information presented to the user is decreased as learning progresses. The information is tracked by the number of times the user has received help in a functional area. The user sets a threshold for the number of times that a level of help information is to be displayed for a particular functional area. When the threshold is reached, the information presented is reduced. Eisen further discloses (col. 4, lines 10-13), that when the user-set thresholds have been met, the application or system overview information would not be shown, unless requested via the regular help facility. Eisen additionally discloses (col. 4, lines 4 and 5) that information can be displayed without the user having to request it. However, in Eisen (col. 2, lines 54-64)

The user is always in control of the amount of

help he or she receives. For example, whenever user-set thresholds are exceeded, the user is

notified and has the option of continuing with the previous level of help/dialog information.

From the teachings of Eisen, we find that the user is always in control of the amount of help provided, and that after a user defined threshold is met, the user is notified and has the option of continuing with the previous level of help information, as opposed to limiting the providing of help information to a given number of occurrences. We therefore conclude that Eisen would not have suggested limiting the displaying of the arrow and remaining time indicators of Okada after identical advice images have been displayed to a player a given number of times.

Accordingly, the rejection of claims 17 and 22 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-8 and 88-22 under 35 U.S.C. § 103 is reversed.

REVERSED

MICHAEL R. FLEMING)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
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